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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/893,038	06/27/2001	Nikhil M. Deshpande	884.484US1	3389
21186	7590	03/02/2004	EXAMINER	
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402			GESESSE, TILAHUN	
			ART UNIT	PAPER NUMBER
			2684	25

DATE MAILED: 03/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/893,038

Applicant(s)

DESHPANDE ET AL.

Examiner

Tilahun B Gesesse

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Specification*

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-10,13-26,28-29 and 31 are rejected under 35 U.S.C. 102(e) as being anticipated by Novakov (6,571,103).

As to claims 1,13,Novakov discloses a communication device (26) comprising: (figures 1 and 5) means for interrogating a plurality of wireless network access service providers (PSTN 14 and wireless access point 12 and bluetooth transceiver (28) and

GSM transceiver (40) of figures 1 and 5, column 4, lines 58-column 5 lines 28) to gather information related to service offering (column 2 line 20-column 3, lines 41), means for obtaining a provider selection criterion associated with a user of the communication device (column 4, lines 31-57 and figures 1 and 5) and means for selecting a service provider from the plurality of wireless network access service providers to provide wireless access to a network for the communication device based on the provider selection criteria and the information (column 5, line 31-column 47 and figures 1 and 5).

As to claims 2,14,16-18,28-29 and 31 Novakov discloses means for wirelessly transmitting a separate interrogation signal for each of the plurality of the plurality of wireless network access service providers (inquiry and negotiation of service of figures 2 and 3).

As to claim 3, 15, Novakov discloses the separate interrogating signal includes an identifier uniquely identifying a corresponding service provider (figures 2 and 3 and it's disclosure).

As to claim 4, Novakov discloses the information includes information related to a cost of service offered by a first wireless network access service provider (column 9, lines 8-20 ).

As to claim 5, Novakov discloses the information includes to connection performance available from a first wireless network access service provider (column 3, line 65-column 4, line 30).

As to claim 6,19-21, Novakov discloses information related to a per user bandwidth available from a first wireless network access service provider

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(communicating as a GSM radio telephone communicating all kinds of data and cordless telephone for voice communication mode is per user bandwidth available from a first wireless network access service provider, column 4, lines 16-50 and figure 5).

As to claim 7, Novakov inherently discloses means of measuring a connection bandwidth associated with a first wireless network access service provider (switching from data mode to voice mode is based on available bandwidth to communicate by sampling).

As to claim 8, Novakov discloses means for requesting a relatively short duration connection from a first wireless network access service provider to allow a connection bandwidth of the first wireless network access service provider to be measured by the communication device (an electronic switch 32 connects the controller and baseband module 34 either to the bluetooth transceiver 28 or to a GSM radio unit 40 , column 4 lines 16-31 and figure 5)

As to claims 9-10, Novakov discloses the means for prompting a user of the communication device for the provider selection criteria using an input out device (column 4 lines 47-57).

As to claim 22-25 Novakov discloses a computer readable medium (column 3 line 65 through column 4, line 6 and figure 1) having program instructions stored thereon for performing (column 6, lines 3-23), when executed within a digital processing device, a method for procuring wireless access to a network (figure 1), comprising; interrogating a plurality of network access service providers for information relating to service offerings; and selecting a service provider form the plurality of

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network access service providers based on the information and a selection criterion (column 4, 58 through column 5, 27).

As to claim 26, Novakov discloses a communication device (26) comprising: (figures 1 and 5) means for interrogating a plurality of wireless network access service providers (PSTN 14 and wireless access point 12 and bluetooth transceiver (28) and GSM transceiver (40) of figures 1 and 5, column 4, lines 58-column 5 lines 28) to gather information related to service offering (column 2 line 20-column 3, lines 41), means for obtaining a provider selection criterion associated with a user of the communication device (column 4, lines 31-57 and figures 1 and 5) and means for selecting a service provider from the plurality of wireless network access service providers to provide wireless access to a network for the communication device based on the provider selection criteria and the information (column 5, line 31-column 47 and figures 1 and 5).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 11-12,27,30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Novakov in view of Pecan et al (6,466,804).

As to claims 11 and 12, Novakov does not expressly teach a removable memory card and a subscriber identification module (SIM). However, Pecan et al discloses a

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server device 200, such as a mobile subscriber unit, having a SIM card 202 intended for use by a signal user inserted within server device 200 (column 3, lines 22-38 and figure 2). Since Novakov, in the similar field endeavor, teach bluetooth enable communication and GSM system. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention was to combine Novakov and Pecen , for accessing a communication using SIM card , as taught by Pecen, in order to identify the user using information in the smart card.

As to claim 27 and 30, Novakov doe not explicitly teach memory to store selection criteria. However, Pecen et al teach subscriber identification module (SIM) card that interface command with client devices (abstract). Since, both prior art in are short range (bluetooth enabled) communication. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Novakov and Pecen in utilizing memory , such as SIM, as taught by Pecen, for authenticating the service provider by sending identification data to the service provider.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Vatenan (6,237,093) discloses communication network and mobile terminal interfacing the internet and voice communication by GSM system (column 3, line 65- column 4, line 38 and figure 1)

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tilahun B Gesesse whose telephone number is 703-308-5873. The examiner can normally be reached on flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung can be reached on 703-308-7745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TBG

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February 25, 2004

*Tilahun B. Gesesse*  
TILAHUN GESSESSE  
PATENT EXAMINER